

**REMARKS**

**Rejections under 35 U.S.C. § 103**

The Examiner rejected claims 1 and 4-7 under 35 U.S.C. § 103 in view of U.S. Patent No. 5,991,292 to Focsaneanu et al., U.S. Patent No. 5,761,294 to Shaffer et al., U.S. Patent No. 5,974,043 to Solomon, U.S. Patent No. 5,751,706 to Land et al. and U.S. Patent No. 6,064,673 to Anderson et al..

Regarding the Examiner's reference to U.S. Patent No. 5,761,294 to Shaffer et al. (hereinafter referred to as "Shaffer"), Applicant points out that claim 1 as presented herein is correctly presented as amended and that claim 1 had been copied incorrectly in previous papers submitted by Applicant. Particularly, claim 1 correctly recites that "converter... splitting a portion of said telephone transmission signal" not "interface machine splitting a portion of said telephone transmission signal." One of several arguments made to distinguish Shaffer in a response to a previous Office Action relied on the incorrectly presented claim without deceptive intent and must be withdrawn. Particularly, one of several distinctions to Shaffer in Applicant's response filed January 8, 2003 to Office Action dated October 9, 2002 argues with respect to "an interface machine splitting a portion of said telephone transmission signal." Applicant respectfully withdraws that argument (page 2, lines 7 – 14) and submits that several other distinctions made with respect to Shaffer therein are valid, and that further distinctions are presented hereinbelow.

In the present Office Action dated 10/1/2003, the Examiner erroneously indicated that Shaffer discloses "a converter electrically interconnected to a telephone interconnection of said remote modem and receiving said telephone signals therefrom and providing output signal." Contrary to the Examiner's characterization, the converter(s) disclosed in Shaffer are not analogous to the converter as claimed in the present application and would not be operative if substituted for the converter in the apparatus of the present invention. Rather, Shaffer discloses a converter (24) converting digital telephone signals for analog transmission to converter (40)

which converts the analog transmission back to digital signals in a digital switching network (42). (Abstract; col. 2, line 65 – col. 3, line 65, Figs 1-3).

Converters (24, 40) disclosed in Shaffer can optionally divide voice information for transmission over a telephone line from call messages for transmission over an analog data network, and although converters (24, 40) disclosed in Shaffer can include a modem, they are not “electrically interconnected to a telephone interconnection of (a) remote modem” as claimed. Rather, converters (24, 40) disclosed in Shaffer have digital ports for communicating with digital telephone systems, and analog ports which are connected to an analog (PSTN or DATA) network.

More importantly, converters (24, 40) disclosed in Shaffer do not teach or suggest the converters of the present invention because converters (24, 40) disclosed in Shaffer perform a function completely different from the function of the converter disclosed and claimed in the present invention. Contrary to the function of the Shaffer converters (24, 40) as described in the preceding paragraphs, the converters of the present invention “provide an audio output that is input to sound processing hardware, e.g., a soundcard, on an interface PC...” (page 4, lines 5-7). Furthermore, the claims of the present invention require that the converter provide an audio output signal (claim 1) or an analog audio output (claim 8). Nothing in Shaffer teaches or suggests converters that provide any type of audio output signal or analog audio output. Rather signals (74, 28) of Shaffer are digital signals communicated via links (28, 74) to digital telephone systems.

The Examiner also incorrectly indicated that U.S. Patent No. 5,751,706 to Land et al. (hereinafter referred to as “Land”) discloses “an interface machine splitting a portion of said audio output signal from said converter.” Applicants note the previous clerical error and again point out that the correct language in claim 1 as previously amended recites “a converter electrically interconnected to a telephone interconnection of said remote modem and splitting a portion of said telephone transmission signals therefrom and providing an audio output signal; (and) an interface machine receiving said audio output signal from said converter, said interface machine including a first sound processing mechanism processing said audio output signal for

transmission over said WAN as a network audio signal.” Applicant respectfully submits that Land discloses voice interfaces for packet based systems that convert between analog or digital voice and the digital packets. (Col. 2, lines 45 – 47). However, no disclosure in Land teaches or suggests either the converter or the interface machine elements as claimed in the present invention. Particularly, Land does not teach or suggest a converter splitting a portion of a telephone transmission signal from a remote modem and providing an audio output signal.

Similarly, Applicants submit that U.S. Patent No. 5,974,043 to Solomon and U.S. Patent No. 6,064,673 merely disclose or suggest means for processing between telephone signals, sound and digital packets for transmission and reception over a WAN. Applicants respectfully direct the Examiner’s attention to Fig. 1 which is consistent with each of the claims in the present invention to more clearly point out the placement and function of the claimed converter and its connection to the telephone line side of a remote modem. Nothing in any of the cited art teaches or suggests anything about splitting a portion of a telephone signal from a telephone interconnection of a remote modem as disclosed and claimed in the present invention.

The Examiner indicated that “functions such as splitting the digital signal, gateway with soundcard for splitting the digital signal to form a packet by using a sound processing mechanism and a converter for converting digital and analog are well known in the art.” Applicants again submit that the claims require a converter splitting (claim 1) or receiving (claim 8) telephone transmission signals not a digital signal as the Examiner indicated.

The Examiner indicated that motivation to combine the many cited references is to reduce cost. Applicant submits that Examiner’s indication that motivation is to reduce cost is without merit. Applicants submit that prior art systems for reducing cost of telephone transmission using a WAN to communicate to remote telephones via remote modem pools are well known as described in the Background of the Invention. The present invention, and especially any supposed combination of the cited references to perform the present invention, may add a substantial number of new components to the such system and therefore may actually increase their cost. Accordingly cost reduction is not a valid motivation to combine. Rather, a proper motivation to combine various elements to achieve the present invention is to provide a

mechanism for listening at a local site, to a transmission over a WAN of communication between the local machine and the remote modem. (See page 3, lines 15-17). No such motivation is suggested in any of the prior art or in the knowledge of persons having ordinary skill in the art.

“Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art” (MPEP 2143.01). Applicant submits that even if each and every element of the present invention were present in the cited art (which Applicants maintain they are not), no motivation to combine exists without the use of improper hindsight and without looking outside of the cited reference. None of the references suggest the desirability of the resultant combination.

Since none of the cited references alone or in any combination with the other cited references teach or suggest each and every element of independent claim 1 or dependent claims 4-7 which depend therefrom, combined according to the claims, the Examiner has not made out a *prima facie* case of obviousness under 35 U.S.C. 103(a). Accordingly, the rejections of claims 1 and 4-7 are improper and should be withdrawn.

The Examiner rejected claims 8-9, 13-16, 19-20 and 23 under 35 U.S.C. 103(a) over Shaffer in view of in view of U.S. Patent No. 6,064,673 to Anderson et al. (hereinafter referred to as “Anderson”).

The Examiner erroneously indicated that Shaffer discloses “a method and system for effecting audible communications between a local system and a remote system over a WAN comprising the steps of: configuring a remote communication mechanism in said remote system to receive a transmission signal and converting said transmission signal into an analog audio output signal, wherein said converting step involves a converter electrically connected to an interconnection of said remote communication mechanism to receive said transmission signals therefrom and to convert said transmission signals into said analog audio output.” Contrary to the Examiner’s characterization, Shaffer discloses a converter (24) converting digital telephone

signals for analog transmission to converter (40) which converts the analog transmission back to digital signals in a digital switching network (42). (Abstract; col. 2, line 65 – col. 3, line 65, Figs 1-3). Even though converter (40) of Shaffer receives a transmission signal, Applicant submits that neither converter (40) nor converter (24) of Shaffer teaches or suggests the structure or function of a converter as claimed which receives a transmission signal and converts it into an analog audio output signal. Rather converter (40) of Schaffer converts the received transmission to digital telephone signal.

The Examiner indicated that the motivation to combine the teachings of Shaffer with Anderson is to reduce cost. Applicant respectfully traverses the stated motivation to combine for the reasons set forth hereinbefore with respect to rejections of claim 1 and 4-7.

Since none of the cited references alone or in any combination with the other cited references teach or suggest each and every element of independent claim 8 or dependent claims 9, 13-16 which ultimately depend therefrom, independent claim 19 or dependent claims 20 or 23 combined according to the claims, the Examiner has not made out a *prima facie* case of obviousness under 35 U.S.C. 103(a). Accordingly, the rejections of claims 8-9, 13-16, 19-20 and 23 are improper and should be withdrawn.

The Examiner also rejected claims 10, 17 – 18, and 18 – 22 under 35 U.S.C. 103(a) over Shaffer and Anderson in view of Focsaneanu and Solomon. Applicant respectfully traverses the Examiner's rejections of claims 10, 17 – 18, and 21-22 for the reasons set forth hereinbefore with respect to rejections of claims 1, 4-7, 8-9, 13-16, 19-20 and 23. Particularly, Applicant submits that the Examiner has not made out a *prima facie* case of obviousness because nothing in Focsaneanu or Solomon cures the deficiencies of Shaffer as set forth above. Furthermore Applicant submits that no proper motivation to combine Focsaneanu or Solomon with Shaffer and Anderson is suggested in the references for the reasons set forth above. Accordingly the rejections of claims 10, 17 – 18, and 18 – 22 under 35 U.S.C. 103(a) are improper and should be withdrawn.

Please charge any deficiency as well as any other fees which may become due at any time during the pendency of this application, or credit any overpayment of such fees to deposit account No. 50-0369. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge deposit account No. 50-0369 therefore.

Respectfully submitted,

12/24/03  
Dated:

Joseph P. Quinn  
Joseph P. Quinn, Esq.  
Reg. No. 45,029  
Customer No. 21710  
Attorney for Applicant

**BROWN RUDNICK BERLACK ISRAELS LLP**

Box IP, 18th Floor  
One Financial Center  
Boston, MA 02111  
Tel: 1-617-856-8396  
Fax: 1-617 856-8201